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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,657

10/09/2003

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

03/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/682,657	POLONKA, JACK	
	Examiner	Art Unit	
	MARINA LAMM	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/07 has been entered.
2. Claims pending are 1-20. Claim 1 has been amended.

The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied in the instant application.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 5-9, 11-13, 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833).

Nogatani et al. teach pigmented and non-pigmented cosmetic compositions containing 0.1-30% by wt. of hollow plate metal oxide particles A (e.g. zirconium oxide)

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having an average particle diameter of 5-12 μm and 0.01-99% by wt. of inorganic particles B (e.g. aluminum oxide, barium sulfate or boron nitride), having platy structure and a refractive index (RI) of 1.6 to 1.8 and a total transmittance of at least 85%. See [0016]-[0018], [0025], [0026], [0031], [0034], Examples. The compositions of Nagatani et al. have "an excellent feeling of transparency". See Abstract; Examples. The compositions contain other conventional cosmetic ingredients such as oil substances, antioxidants, moisturizers, surfactants, perfumes, etc. See [0049]-[0051]; Examples. Nagatani et al. does not explicitly teach the claimed opacity of the composition of less than about 20%. However, the compositions of Nagatani et al. have "an excellent feeling of transparency", "brightness" and "natural finish". See above. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to determine an optimal or workable opacity of the composition by routine experimentation. One having ordinary skill in the art would have been motivated to do this to obtain the desired transparency and natural finish of the composition as suggested by Nagatani et al. With respect to Claims 6 and 20, the reference does not explicitly teach the claimed particle thickness. However, determination of optimal or workable particle thickness by routine experimentation is obvious absent showing of criticality of the claimed parameter. One having ordinary skill in the art would have been motivated to do this to obtain the desired transparency and natural finish of the composition.

5. Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) in view of Dreher (US 2003/0157041), of record.

Nagatani et al. applied as above. Nagatani et al. do not teach bismuth oxychloride of Claims 4 and 18. However, Dreher teaches using plate-like bismuth oxychloride particles having an average particle size of 3-20 μm for the same purpose as boron nitride and barium sulfate powders of Nagatani et al. See [0010]. The compositions of Dreher provide soft, translucent glowing effect to the skin, which is due to the presence of the inorganic particles. See [0010]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to use bismuth oxychloride particles instead of boron nitride or barium sulfate particles. One having ordinary skill in the art would have a reasonable expectation of obtaining the same cosmetic emollient effect as set forth in the Nagatani et al. reference because these particles are used interchangeably for the same art-recognized purpose as suggested by Dreher. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). With respect to Claim 10, Nagatani et al. do not explicitly teach the particles suspended in a polar solvent prior to incorporation in the composition as claimed herein. However, Dreher teaches making optical make-up compositions for minimizing skin flaws by first suspending bismuth

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oxychloride and other inorganic particles in butylene glycol (polar solvent), then adding the mixture to the water (polar solvent) and pigments mixture; and then mixing the resulting water phase (with pigment particles suspended in it) with the oily phase. See Example 1 @ pp. 2-3. The compositions of Dreher, when applied to the skin, give a high feeling of transparency, hide imperfections and give natural feeling and appearance of the skin. See [0004]. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Nagatani et al. such that to suspend their platelet particles in polar solvents before incorporating the particle into the composition. One having ordinary skill in the art would have been motivated to do this to obtain imperfection-concealing compositions having natural skin feel and appearance as suggested by Dreher.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) in view of Tan et al. (US 6,511,672), of record.

Nogatani et al. applied as above. While teaching skin benefit agents, Nagatani et al. do not explicitly teach the specific benefit agents of the instant claim. However, Tan et al. teach skin benefit agents such as vitamins (e.g. vitamin A or retinol, vitamins C and E), skin lightening agents, alpha- or beta-hydroxy acids, etc. in skin imperfection-concealing compositions. See col. 7, lines 32-64. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to employ retinol or other skin benefit agents of Tan et al. for their art-recognized purpose. One having ordinary skill in

the art would have a reasonable expectation of beneficial results such as an antioxidant effect.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

7. Applicant's arguments filed 12/21/07 have been fully considered but they are not persuasive.

The Applicant argues: "In contrast [to the Applicant's invention], and as already made of record, the '833 reference merely discloses a cosmetic composition having metal oxide plate powder with a hollow structure. The cosmetic composition provides a feeling of transparency by causing a remarkable change in hue. Paragraph 27 of the '833 reference clearly mentions that when inorganic powder having a refractive index of 1.6-1.8 is used, such a component is used at a concentration of 20% by weight. Applicant respectfully points out to the Examiner that when particles having an index of refraction of 1.8-2.2 are used in the composition of the invention as claimed, about 0.01% to about 1.0% by weight of the solid single- crystal, flat, platy particles are used. Twenty percent (20%) is not used as described in the '833 reference. Furthermore, the cosmetic compositions described in the '833 references require hollow plate powder (A) so that various color tones may be prepared. The present invention, again as now presented, does not require hollow plate powders to generate various color tones. In fact, the compositions of the present invention provide a radiant appearance to skin and a colorless or natural skin finish. In view of the above, it is clear that all of the important and critical limitations set forth in the presently claimed invention are not found in the '833 reference. Therefore, the rejection made under 35 USC §103 should be withdrawn and rendered moot." See p. 8 of the reply.

In response the following is noted: (1) the instant claims do not exclude the presence of additional ingredients, such as hollow particles. The claim language "consisting essentially of" does not exclude the presence of additional components unless the Applicants provide an evidence that the presence of those additional components "would materially affect the basic and novel characteristics of the claimed

invention." See MPEP 2111.03 citing *In re Hertz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The Applicant presented no evidence that the presence of hollow particles would materially affect the basic and novel characteristics of the claimed invention. According to MPEP 2111.03 (citing *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)), the Applicant "has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." Further, it is noted: (2) the Nagatani reference clearly teaches that the content of platy particles (B) in the cosmetic composition "is preferably 0.01 to 99% by weight." See [0034]. The above-referenced paragraph [0027] merely exemplifies one of the preferred embodiments of the Nagatani's invention.

In response to the Applicant's argument that "[s]ince the amount [of particles] employed in the compositions of the '833 reference is significantly higher than those claimed in the present inventions, the combination of the '833 reference with the '041 reference does not render the claimed invention obvious" (see pp. 10-11 of the reply), it is noted that the Nagatani reference teaches the broad concentration range of 0.01-99% by weight of the platy particles as discussed above. It would have been obvious and within skill of the ordinary practitioner to select optimal or workable concentration of the particles within the broader range taught by the reference in order to achieve the desired optical and cosmetic properties of the composition.

In response to the Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

8. No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner, Art Unit 1617
3/14/08

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Supervisory Patent Examiner, Art Unit 1617